

S/N: 10/710,788  
Reply to Office Action of December 1, 2005

Atty Dkt No. 81101893 (FMC 1770 PUS)

**Amendments to the Drawings:**

The attached sheet of drawings includes new Figure 5. This sheet, which includes Figure 5, is new and does not replace any original drawing sheets.

Attachment: Replacement Sheet

## Remarks

Claims 1-20 are pending in the application and were rejected. By this Amendment, claims 1, 2, 5, 7, 11, 12, 14, 16 and 18 have been amended. Reconsideration of the claims is respectfully requested. No new matter has been added.

### Rejection Under 35 U.S.C. § 112

Claims 1-20 were rejected under § 112, first paragraph. In a telephone interview with the Examiner on February 6, 2006, various embodiments of the invention were discussed and the Examiner indicated that this rejection would be overcome if the terminology in the claims better matched the specification. Applicants have amended claims 1, 5, 11, 12 and 18 to recite an “adjustment member,” which exactly matches terminology in the specification. Claims 7 and 14 have been amended to recite that the second section of the connection tube is at least partially disposed in the body portion of the adjustment member. Applicants have not made any amendments with respect to the “conduit” since Applicants believe that this feature was clarified during the telephone interview. In particular, claim 1 states that the body portion of the adjustment member is at least partially disposed in the conduit, which is the “narrow portion” of the tool holder (indicated by reference numbers 32, 132, 232 and 332). Likewise, Applicants also believe the location of the spring relative to the conduit as recited in claims 3 and 17 is appropriate. Regarding claims 11 and 12, the connection tube 50 may be integrally formed with the adjustment member 16 by providing the connection tube as part of the body section rather than as a separate component. Applicants have added Figure 5 to more clearly show such an embodiment. Based on these comments and amendments, Applicants respectfully believe that this rejection has been cured.

### Rejection Under 35 U.S.C. § 102

Claims 1, 4, 5, 7-9, 11-15, 18 and 19 were rejected under § 102(b) as being anticipated by U.S. Patent No. 4,640,652 issued to Rivera, Jr. (hereinafter “Rivera Jr. ‘652”). Applicants respectfully believe that a *prima facie* case has not been established. Independent claims 1, 11 and 18 recite “an adjustment member” having “a body portion” and “a flange

portion.” Applicants respectfully believe that Rivera Jr. ‘652 does not disclose a flange portion as claimed. In the Office Action, the Examiner did not specify with particularity any feature as being a flange portion and did not present any arguments or comments regarding a flange portion. Applicants invite the Examiner to point out with particularity what might be considered a flange portion and to provide additional details or arguments. As the rejection currently stands, a *prima facie* case has simply not been established and Applicants request that this rejection be withdrawn. Since claims 4, 5, 7-9, 12-15 and 19 depend on claims 1, 11 and 18, Applicants believe that a *prima facie* case has not been established for the rejection of these claims for the same reasons.

Claims 1-9 and 11-20 were rejected under § 102(b) as being anticipated by U.S. Patent No. 4,591,300 issued to Weiblen (hereinafter “Weiblen ‘300”). Applicants respectfully believe that a *prima facie* case has not been established for the following reasons.

Independent claims 1, 11 and 18 recite an adjustment member having a body portion and a flange portion. In the Office Action, the Examiner referenced the “area of reference number 15 or 26” as being an adjustment member (see Office Action, page 5). Reference number 15 is “a rear tube section” (see column 3, line 37). Reference number 26 is a “bushing holder” (see column 3, line 32). The Examiner did not specify with particularity any feature as being a body portion or provide any comments that clarify what might be considered a body portion. In addition, the Examiner referred the Applicants to “figure 1 near reference number 26” as being a flange portion. The area near reference number 26 shows a bushing holder 26 that is spaced apart from the rear tube section 15 (note the clear gap between the front tube section 14 and the bushing holder 26 as well as drill bushing 27 in Figure 1). Thus, there is no feature near reference number 26 that is disposed adjacent to the rear tube section 15 as recited in the independent claims. Moreover, since the Examiner did not identify with particularity a body portion, Applicants are left to guess as to what might be considered “a flange portion that is disposed adjacent to the body portion” in accordance with claims 1, 11, and 18. Applicants invite the Examiner to present additional arguments and to point out with particularity what might be considered a body portion. As the rejection

currently stands, a *prima facie* case has not been established and Applicants must request that this rejection be withdrawn.

In addition, claims 1, 11 and 18 recite “a spring configured to bias the adjustment member to engage the end surface [of the cutting tool] to inhibit fluid leakage.” Weiblen ‘300 does not disclose a spring that is configured to bias an adjustment member to engage an end surface of a cutting tool to inhibit fluid leakage. Instead, spring 28 in Weiblen ‘300 presses a drill bushing holder 26, a sealing ring 30 and a drill bushing 27 “against the end face 29 of the bore 20” (see column 3, lines 31-35). A bore is not a cutting tool. Moreover, bore 20 cannot received in a counterbore of a tool holder as recited by claims 1, 11, and 18. It follows that the end face 29 of the bore 20 cannot properly be considered an end surface of a cutting tool.

For these reasons, Applicants respectfully believe that a *prima facie* case has not been established and request that the rejection of claims 1, 11 and 18 be withdrawn. Since claims 2-9, 12-17, 19 and 20 depend on claims 1, 11 and 18, Applicants believe that a *prima facie* case has not been established for the rejection of these claims for the same reasons.

Applicants respectfully request that the Examiner point out with particularity all claim limitations that are believed to be found in the prior art relied upon in the rejection. For example, the Examiner referenced Figure 1 as having a chamfer (see Office Action, page 5). However, Applicants can find no chamfer in Figure 1 that is “disposed proximate the fluid passage and adapted to engage the end surface” of a cutting tool as recited in claim 4. Applicants want to help the Examiner advance prosecution of this case, but need the Examiner’s assistance to insure that any rejections are fully understood.

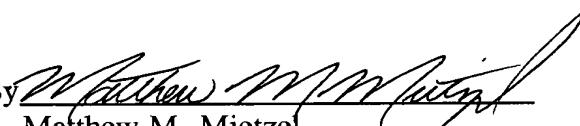
**Rejection Under 35 U.S.C. § 103**

Claims 2, 3, 6, 10, 16, 17 and 20 were rejected under § 103(a) as being unpatentable over Rivera, Jr. '652 in view of Weiblen '300. Claims 2, 3, 6 and 10 depend on independent claim 1. Claims 16 and 17 depend on independent claim 11. Claim 20 depends on independent claim 18. Consequently, Applicants believe that these claims are allowable for the reasons previously discussed.

**Conclusion**

Applicants have made a genuine effort to respond to the Examiner's objections and rejections in advancing the prosecution of this case. Applicants believe all formal and substantive requirements for patentability have been met and that this case is in condition for allowance, which action is respectfully requested.

Respectfully submitted,  
**ALEXANDER STOLL et al.**

By   
Matthew M. Mietzel  
Reg. No. 46,929  
Attorney for Applicant

Date: February 15, 2006

**BROOKS KUSHMAN P.C.**  
1000 Town Center, 22nd Floor  
Southfield, MI 48075-1238  
Phone: 248-358-4400  
Fax: 248-358-3351